

REMARKS

No new matter has been added with this Response. Applicants respectfully solicit an Advisory Action reconsidering the rejections in light of the following remarks. Applicants submit that current claims 44-58 are in condition for allowance.

In the Final Action mailed April 3, 2006, the Examiner rejected claims 44-47 and 51-54 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,766,305 to Fucarile et al. (hereinafter “Fucarile et al.”) in view of U.S. Patent Application Publication 2002/0087476 to Salas et al. (hereinafter “Salas et al.”). The Examiner also rejected claims 48-50 and 52 under 35 U.S.C. § 103(a) as being unpatentable over Fucarile et al. and further in view of U.S. Patent Application Publication 2004/0078490 to Anderson (hereinafter “Anderson”). Claim 56 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fucarile et al. and further in view of U.S. Patent Application Publication 2001/0013011 to Daly et al. (hereinafter “Daly et al.”). Claims 55, 57 and 58 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Fucarile et al. and further in view of U.S. Patent Application Publication 2001/0032312 to Runje et al. (hereinafter “Runje et al.”).

There Is No Motivation To Combine Fucarile Et Al. With Salas Et Al.

Regarding claim 44, the only independent claim, the Final Office Action repeats the Examiner’s previous rejection, stating that Fucarile et al. “does not disclose a license associated with the selected content” and that it would have been obvious to modify Fucarile et al. with Salas et al. “to include a license associated with the selected content...for the license to be pertinent to the user and the licensor such that the wrong license does not get associated with the

wrong content.” Going further, the Final Office Action concluded that “Fucarile discloses verification of licenses in an automatic manner,” because “[T]he express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. § 102 or 103.”

While an inherent or implicit reference may be relied upon in the rejection of claims as pointed out in the Final Office Action, there remains the requirement that a motivation to combine the references exist. In the case at hand, one of ordinary skill in the art would not be motivated to combine the Fucarile et al. and Salas et al. references. In fact, use of the “automatic” license of Fucarile et al. actually teaches away from using the license string as taught by Salas et al.

The abstract of Salas et al. teaches generating a license string for a product and transmitting the license string to a user of the product as part of a method of controlling access to the product. However, the specification of Salas et al. makes clear that its license string is different than that disclosed in Applicants’ claims. In Salas et al., a requestor of a product must input the license string into the product in order to gain access.¹ Therefore, when the invention of Salas et al. is used, license verification cannot be automatic until the user enters the license string into the product.

In Applicants’ claims, however, when the user attempts to gain access to the selected content, its computer automatically verifies the presence of a proper license and that access

¹ At col. 10, paragraph 130, Salas et al. states that “The license string may be derived from information associated with the product, information associated with the request, or other information *that allows the license string to be verified when entered into the product by a user to gain access to the product.*” (emphasis added). Additionally, at col. 10, paragraph 132, Salas states that “The product receives *the license string input by the requestor* (step 1308). The requester *may input the license string by typing the license string into an entry field provided by the product.*” (emphasis added). Furthermore, at col. 10, paragraph 133, Salas states that “The product verifies *the license string input by the requestor*” (emphasis added).

conditions are met, independent of any user interaction with the license. Thus, the user is not required to take any action to show that he or she possesses a license associated with the selected content. The user never sees the license and does not enter any license string into the selected content. One would therefore not be motivated to combine Fucarile et al. with Salas et al. to produce Applicants' invention, since it would be impossible to automatically verify the presence of a proper license in the claims of Salas et al. without first entering the license string into the product. Applicants' claims require verification without any user interaction.

The Motivation To Combine Suggested In The Final Office Action Is Improper

Applicants further argue that the motivation offered by the Final Office Action does not suggest a motivation to combine the invention of Salas et al. with Fucarile et al.'s "automatic" license. Instead, the Final Action states that "[I]t would have been obvious to modify Fucarile et al. to include a license associated with the selected content such as that taught by Salas et al. in order to for the license to be pertinent to the user and the licensor such that the wrong license does not get associated with the wrong content." The Final Office Action discusses a motivation to modify Fucarile et al. with a license associated with selected content as taught by Salas et al. ("such that the wrong license does not get associated with the wrong content") - but this stated motivation does not suggest why one would be motivated to combine Salas et al. with Fucarile et al.'s "automatic" license.

Applicants respectfully submit that the Final Office Action does not provide any teaching, suggestion or motivation to combine the features in the cited patents to create Applicants' specific invention, and indeed that one cannot be found, since Salas et al.'s license actually teaches away from the "automatic" license of Fucarile et al. The fact that discrete

elements within the claims can be found somewhere in the prior art, and “can be used” in combination, does not, without more, render the combination unpatentable.² The Final Office Action must identify some teaching, suggestion or motivation to combine the references.³ “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.”⁴ No proper teaching, suggestion or motivation to combine has been identified in the present case.

The Federal Circuit has addressed the sufficiency of the reasoning provided. In *In re Sang-Su Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002), the Court reversed a finding of obviousness since there was no motivation to combine two references to result in the claimed invention. The invention was a method of displaying functions of a video display device comprising entering a picture adjustment mode having a picture menu screen if a demonstration mode is selected.⁵ Reference A described a television set having a menu display by which the user can adjust various picture and audio functions.⁶ Reference B described a video game display as having a demonstration mode showing how to play the game, but it did not mention the adjustment of picture or audio features.⁷

The Examiner of *In re Sang-Su Lee* stated that “it would have been obvious to one of ordinary skill in the art since the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration

² See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (“As this court has stated, ‘virtually all [inventions] are combinations of old elements.’”).

³ See, e.g., *In re Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456.

⁴ *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

⁵ *In re Sang-Su Lee*, 277 F.3d at 1340.

⁶ *Id.*

mode is user friendly and it functions as a tutorial.”⁸ The Court, in reversing the determination of obviousness stated that the Examiner’s conclusory statements “do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief... It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[u]se that which the inventor taught against its teacher.’”⁹

Similar to *In re Sang-Su Lee*, the Examiner’s statement does not provide adequate motivation to combine specific elements of the references into the single claimed invention. At the very best, the statement regarding motivation in the Final Office Action may be suitable motivation *to use* the elements purportedly taught by Fucarile et al. and Salas et al. in a general sense. But, they do not provide the motivation *to combine* the specific elements of Fucarile et al. with Salas et al. to arrive at the presently claimed invention. And, as noted above, one would not be motivated to modify Fucarile et al. with Salas et al., since by the very nature of the Salas et al. invention, license verification cannot be automatic.

Because claims 45-58 all depend from independent claim 44, Applicants respectfully submit that all pending claims are now in condition for allowance in view of the above remarks.

CONCLUSION

Applicants therefore respectfully submit that the cited references do not teach all of the elements of Applicants’ claims. In view of the above remarks, it is submitted that this application is now ready for allowance. If, in the opinion of the Examiner, a telephone


⁷ *Id.*

⁸ *Id.* at 1341.

⁹ *Id.* at 1344 (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)).

conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (213) 896-6897.

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